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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/999,730	12/24/1997	ROBERT H. STAAT	7311-24RE	4290

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PHILADELPHIA, PA 19103

EXAMINER

MORANO IV, SAMUEL J

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

08/999,730

Applicant(s)

STAAT, ROBERT H.

Examiner

S. Joseph Morano

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-- The MAILING DATE of this communicati n appears on the c ver sheet with the corresp ndence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-9 is/are allowed.
- 6) ☒ Claim(s) 10-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>32</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. In view of the Appeal Brief filed on February 20, 2002, PROSECUTION IS HEREBY REOPENED. An Office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The amendment filed January 11, 2002 has been entered and considered for the purposes of this Office action as was indicated in the Advisory Action of January 23, 2002. The pending claims are 2-34. It should be noted that amendment filed January 11, 2002 was a substitute for the one originally filed on January 02, 2002. The fax of January 02, 2002 inadvertently contained two page 2's and no page 3's. The amendment of January 11, 2002 corrected this problem. Accordingly, the amendment of January 11, 2002 is the one that was entered and was the one considered and referred to in the Advisory Action.

3. During an additional review of the claims, the following inconsistency in claim language was noted. As the meets and bounds of the claims are clear, correction of the following is *suggested*, but not required:

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On line 1 of claims 7, 8, 15, 21, 28, and 34 "coupler knuckle" should read
-coupler assembly- in order to be consistent with the preambles of the previous claims
from which these claims depend.

Reissue Applications

4. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

Specifically, the latest reissue declaration on file (filed June 12, 2001) does not cover the changes made by newly added claims 22-34. These claims were not present prior to the appeal and were only entered upon filing of the appeal brief. Applicant's representative was advised of this defect in a telephone interview, but was unable to file a supplemental declaration in time.

5. Claims 22 -34 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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10 72-76 18-20

6. Claims 10, 12, 16 and 18-20 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of "**the combination of all of the features claimed in claim 7** (patent claim 1), in particular with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring" (emphasis added). Because the application was allowed based on these limitations, and because applicant did not comment or request clarification from the examiner with respect to these reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside of the scope

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of the combination of elements in originally allowed claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. The specific elements of the allowed combination that are missing are:

In claims 10, 12-15, the limitations of *a leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

In claims 16, 18-20, the limitations of *a leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

Allowable Subject Matter

7. Claims 11, 17 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 22-34 would be allowable upon submission of an acceptable supplemental oath/declaration as noted above.

9. Claims 2-9 are allowed.

Response to Arguments

10. Applicant's arguments filed in the appeal brief of February 20, 2002 have been fully considered but they are not persuasive.

Applicant's arguments are essentially the same as those that are already on the record, and the examiner's position relative to the issue of recapture has been exhaustively set forth in the record. Applicant continues to argue that the recapture rejection was improper because of a lacking in evidence of a clear agreement by the inventor or his attorney with the examiner's statement of reasons for allowance. Applicant states that the examiner's reliance on the failure to comment on the examiner's reasons for allowance is unfounded and inequitable, as the rule specifically states that failure to comment is not acquiescence as to why the application was allowed. Applicant makes the additional argument that the prosecution history shows that the examiner didn't really mean what was explicitly stated in the reasons for allowance.

It should be noted that upon reconsideration of the record as a whole, the rejection of claims 9, 11, 17 and 21 under recapture has been reconsidered for the reasons discussed in the interview with applicant's representative (Summary paper #32, attached). In these claims, since applicant did not actually eliminate an element essential to the allowable combination but simply broadened specific aspects of these elements, upon reconsideration, recapture does not apply. No essential combination of features referred to in the original reasons for allowance is actually missing or was eliminated. All of the elements essential to the combination are there, some of them just in broadened form as to their attachment and/or formation. In the remaining claims where applicant has actually eliminated one of these essential features altogether, i.e. the elimination of the "leaf spring" element, recapture does still apply because an essential allowable feature is not present. This was again discussed in the interview, and in an effort to expedite the lengthy prosecution of this application, a

suggestion to re-introduce the leaf spring, possibly as just a spring to allay applicant's fears of ease of infringement, was suggested by the examiner. In the currently pending claims 10, 12-16 and 18-20; however, this essential element is still completely eliminated from the combination. To the extent that applicant's arguments apply to this remaining issue of recapture, these arguments are not persuasive for the reasons set forth below.

In response to applicant's arguments, it is believed that the evidence of record clearly does show applicant's acceptance of the examiner's reasoning for allowance of the application, and thus applicant's statement in this regard is factually inaccurate. As set forth in paragraph 2 of the Office action mailed 10/31/95 in parent application 08/292,880: "Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee...". Because no comments regarding the error in the examiner's reasoning as to why the application was being allowed were considered necessary by applicant, applicant agreed on the record with why *the examiner* was allowing the application. This is not necessary the same as agreeing with the examiner's reasons, as correctly noted in applicant's citation of the rule. Thus, the evidence of record does in fact show that applicant acquiesced to the fact that *these were the reasons that the examiner was allowing the application*, namely the combination of "all of the features claimed in claim 7".

While applicant's failure to comment may not constitute agreement with the examiner's reasoning, this is not a catchall preventative to appliance of the recapture doctrine. At the time of allowance, the examiner clearly stated on the record that *the examiner* believed all of the features of claim 7 were necessary for allowance. While applicant's opinion as to the necessity of all of the features may have differed,

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applicant nonetheless accepted the fact that this is why *the examiner* was allowing the application, and did not request any clarification from the examiner as to whether or not the examiner actually meant that each and every feature present in the recited combination of the claim was necessary for patentability. The attempt to remove material that *the examiner* deemed necessary for patentability is in fact recapture, regardless of applicant's opinion as to the validity of the examiner's reasoning.

In response to the statements in the appeal brief that the examiner's actions would prevent any broadening reissue, it should be noted that applicant's remarks were considered and led to the reconsideration of the rejection of claims 10, 12-16 and 18-20. The recapture doctrine is intended to prevent elimination of features deemed necessary to the patentability of the claims during the prosecution history of the application, and not to prevent permissive broadening of the claims. Thus, in looking at the claims upon reconsideration, those claims where essential features were not eliminated but simply broadened, recapture would not apply and those rejections have been dropped. However, for those claims where features that the examiner specifically stated on the record were necessary for allowance have been completely removed from the claimed combination and not simply broadened, recapture does apply and those are the rejections pending.

Applicant has suggested in the remarks that despite the clear and unambiguous language of the examiner in the reasons for allowance, the examiner really only meant *some* features of the combination were essential, not *all* of the features of the combination were essential. Applicant's reliance on what applicant thinks the examiner might have meant is no substitute for the actual language explicitly set forth in the reasons for allowance. If applicant had submitted a claim

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where only "stops" were claimed, such a claim would not have been allowed, although applicant's arguments in the brief would seem to suggest this. Clearly it is the use of stops in combination with other claimed structure that made the claims allowable as a whole, and as set forth by the examiner, it was all of the features of claim 7 in combination with this feature that made the claim patentable. Applicant's remarks key on the fact that the examiner indicated original claim 4 as allowable as they related to the stops, but conveniently de-emphasize the fact that claim 4 was a dependent claim, and as such, included the combination of all of the elements of its parent claim(s). The combination of elements of dependent original claim 4 and its original parents is the exact same combination of features recited in the reasons for allowance.

For all of the reasons set forth above, the rejection is deemed proper and will not be withdrawn.

11. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Supervisory Patent Examiner Morano can normally be reached Monday through Thursday, 7:00am-4:30pm.

Sjm
May 16, 2002



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